

## **REMARKS/ARGUMENTS**

This Amendment responds to the Office Action dated December 31, 2009, in which the Examiner rejected claims 1-2, 4-6 and 8-11 under 35 U.S.C. § 103.

As indicated above, claims 1, 4 and 8-9 have been amended in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability.

Claims 1-2 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011) in view of *Ellis, et al.* (U.S. Publication No. 2003/0149988).

*Kuroda* appears to disclose allowing a user to choose another storage device or to record to another storage device (column 5, lines 60-65). Nothing in *Kuroda* shows, teaches or suggests issuing a recording substitution request to an external device which separately receives a program from a distribution center independently of the recording system such that the external device records the program received from the distribution center as claimed in claim 1. Rather, *Kuroda* only discloses allowing a user to select another storage device or to record to another storage device.

*Ellis, et al.* appears to disclose a main facility 12 providing program guide data to interactive program guide television equipment 17 via a communications link 18 [0058]. As shown in Figures 2A-2E, the interactive program guide television equipment 17 includes program guide distribution facility 16 and user television equipment 22 [0062]. Remote media server 24 records programs and associated program guide data in response to record request [0084].

Thus, *Ellis, et al.* merely discloses an interactive program guide television equipment 17 receiving program information for the remote media server 24 and user television equipment 22.

Nothing in *Ellis, et al.* shows, teaches or suggests an external device separately receiving program from a distribution center independently of the recording system wherein the external device records the program received from the distribution center in response to a recording substitution request as claimed in claim 1. Rather, since the remote media server 24 and television 22 of *Ellis, et al.* are both part of the interactive program guide television equipment 17, both remote media server 24 and user equipment 22 receive the program through the same communication link 18.

A combination of *Kuroda* and *Ellis, et al.* would merely suggest that the user television equipment 22 of *Ellis, et al.* be used for the program of *Kuroda*. Thus, nothing in the combination of the references shows, teaches or suggests an external device separately receiving a program from a distribution center independently of the recording system as claimed in claim 1. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 1 under 35 U.S.C. § 103.

Claim 2 depends from claim 1 and recites additional features. Applicant respectfully submits that claim 2 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Ellis, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 2 under 35 U.S.C. § 103.

Claims 4-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and *Zigmond, et al.* (U.S. Patent No. 6,698,020).

*Kuroda* appears to disclose a temporary storage device 103 and a storage device 105 storing content signals according to a viewers direction (column 4, lines 30-39). A program recorded in the storage device 105 is held until another intentional direction to delete the program is given by a viewer (column 4, lines 47-49).

Thus, *Kuroda* merely discloses temporary storage device 103 and storage device 105. Nothing in *Kuroda* shows, teaches or suggests a first storage means/portion for storing program content of a program and a second storage means/portion for storing the program content (a) with advertising information selected for at least one of the external devices as claimed in claim 4 or (b) with advertising content received independent of the distribution station as claimed in claim 9. Rather, *Kuroda* only discloses temporary storage device 103 and storage device 105 which stores data until a viewer intentionally deletes this program.

As discussed above, *Ellis, et al.* merely discloses interactive program guide television equipment 17 receiving program guide information via a communication link 18 where the equipment 17 includes user television equipment 22 and remotes media server 24. Nothing in *Ellis, et al.* shows, teaches or suggests first storage means/portion for recording program content of a program from a distribution station and second storage means/portion for storing the program content (a) with advertising information selected for at least one of the external devices as claimed in claim 4 or (b) with advertising content received independent of the distribution station as claimed in claim 9. Rather, *Ellis, et al.* merely discloses interactive program guide television equipment 17, containing remote media server 24 and user television equipment 22, receives program information through communication link 18.

*Zigmond, et al.* appears to disclose selecting appropriate advertisements based on at least whether the video programming feed is watched as it is broadcast or being replayed from recorded media. Advertisers can update time sensitive advertisements when such advertisements have been recorded. Originally recorded on videotape or other recorded media can be replaced with effectively targeted ads based on any other desired criteria (column 14, lines 1-12).

Advertisement repository 86 may comprise conventional magnetic tape or any other recorded media for storing an analog version of the video programming feed (column 15, lines 31-34).

Thus, *Zigmond, et al.* merely discloses an advertisement repository. Nothing in *Zigmond, et al.* shows, teaches or suggests a first storage means/portion for storing program content of a program from a distribution station and second storage means/portion for storing the program content (a) with advertising information selected for at least one of the external devices as claimed in claim 4 or (b) with advertisement content received independent of the distribution station as claimed in claim 9. Rather, *Zigmond, et al.* merely discloses an advertisement repository.

The combination of *Kuroda, Ellis, et al.* and *Zigmond, et al.* would merely suggest to have temporary storage device 103 and storage device 105 as taught by *Kuroda*, to have an interactive program guide television equipment 17, containing the remote media server and television user equipment, receive programs via communication link 18 as taught by *Ellis, et al.* and to have an advertisement repository as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests first and second storage means/portion where the second storage means stores the program content (a) with advertising information selected for at least one of the external devices as claimed in claim 4 or (b) with advertising content received independent of the distribution station as claimed in claim 9. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 4 and 9 under 35 U.S.C. § 103.

Claims 5-6 depend from claim 4 and recite additional features. Applicants respectfully submit that claims 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda, Ellis, et al.* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore,

Applicants respectfully request the Examiner withdraws the rejection to claims 5-6 under 35

U.S.C. § 103.

Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* (U.S. Patent No. 5,805,763).

As discussed above, *Kuroda* merely discloses allowing a viewer to choose another storage device or to record the storage device. Nothing in *Kuroda* shows, teaches or suggests an external storage device separately receiving a program from a distribution center independent of the recording system wherein the external storage device records the program received from the distribution center when a record substitution request is issued by an issue portion as claimed in claim 8. Rather, *Kuroda* only discloses when capacity is reached, a viewer is allowed to choose another storage device or to record the storage device.

*Lawler, et al.* appears to disclose a user can set a record tag by activating a record button 130 in a menu 136 (column 12, lines 29-32). When a record tag is set, it is stored at a head end 12. In this manner, the head end can monitor all the record tags set by the various system users (column 13, lines 8-12).

Thus, *Lawler, et al.* merely discloses having a user set a record tag by activating a record button in a menu. Nothing in *Lawler, et al.* shows, teaches or suggests automatically issuing a record substitution request when the recording system fails such that the external storage device records the program received from the distribution center separately and independent of the recording system when the record substitution request is received as claimed in claim 8. Rather, *Lawler, et al.* only discloses a user setting a record tag by activating a record button on a menu.

A combination of *Kuroda* and *Lawler, et al.* would merely suggest that if the system has insufficient capacity to notify the user as taught by *Kuroda* and in addition to have the user set a

record tag to have the system monitor the tag as taught by *Lawler, et al.* Thus, nothing in the combination of the referencees shows, teaches or suggests an external storage device separately receiving a program from a distribution center independent of the recording system as claimed in claim 8. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 103.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and further in view of *Zigmond, et al.* Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* and further in view of *Zigmond, et al.*

Applicants respectfully traverse the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the reference to *Kuroda* shows, teaches or suggests the primary features as claimed in claims 1 and 8, Applicants respectfully submit that the combination in the primary reference with the secondary references to *Ellis, et al.*, *Zigmond, et al.* and *Lawler, et al.* will not overcome the deficiencies of the primary reference. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 10 and 11 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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